

NEIFELD DOCKET NO: PIP-53-FITZ-US

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: FITZPATRICK CONF. NO: 9232

GROUP ART UNIT: 3691

SERIAL NO: 09/730,592

FILED: December 7, 2000

EXAMINER: OLABODE

FOR: Price Paid Database

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22213-1450

37 CFR 41.37 APPEAL BRIEF REINSTATING THE APPEAL

Sir:

In response to the office action dated 5/6/2008, the appellants file herewith another appeal brief and notice of appeal, thereby reinstating the appeal.

The office action dated 5/6/2008 was further to the response filed 10/16/2006 to the notice of non-compliant appeal brief mailed 9/25/2006, which was further to the appeal brief filed 7/11/2006, which was further to the Order dated 6/27/2006, which was further to the reply brief filed 5/22/2006, which was in response to the examiner's answer dated 4/21/2006, which was further to the notice of appeal and appeal brief filed 6/16/2005, which was in response to the office action mailed 11/4/2005 and the office communication dated 5/31/2005, which were in response to the appeal brief and notice of appeal filed 3/11/2005, which was further to the notice of appeal filed 2/4/2005.

Table of Contents

I.	37 CFR 41.37 (a)(1) and (2) - Notice Of Appeal, Brief, and Fees	<u>1</u>
II.	37 CFR 41.37 (b) - Dismissal of Appeal if Brief and Fees Untimely	<u>1</u>
III.	37 CFR 41.37 (c)(1)	<u>1</u>
A.	37 CFR 41.37 (c)(1)(i) Real Party in Interest	<u>1</u>
B.	37 CFR 41.37 (c)(1)(ii) - Identification of Related Appeals and Interferences	<u>1</u>
C.	37 CFR 41.37 (c)(1)(iii) - Status of Claims and Identification of Claims, and Identification of Claims being Appealed	<u>1</u>
D.	37 CFR 41.37 (c)(1)(iv) - Status of Amendments	<u>1</u>
E.	37 CFR 41.37 (c)(1)(v) - Summary of the Claimed Subject Matter	<u>2</u>
F.	37 CFR 41.37 (c)(1)(vi) - Grounds of Rejection to be Reviewed on Appeal	<u>4</u>
G.	37 CFR 41.37 (c)(1)(vii) Argument	<u>5</u>
IV.	Whether the Rejection of Claim 1 under 35 USC 112 Should Be Reversed	<u>5</u>
V.	Whether the Rejections of Claims 45-55, or of Claims 40-49, 52 and 55, or of claims 40-55, Under 35 USC 101, Should Be Reversed	<u>9</u>
	1. Summary	<u>9</u>
	2. Mis-Application of <u>Warmerdam</u>	<u>11</u>
	3. Improper Reliance Upon <u>Lowry</u>	<u>12</u>
	4. Misapplication of Printed Matter Theory	<u>12</u>
VI.	Whether the Rejections of Claims 1-55 under 35 USC 103, Which Rely Upon: Daniel (US 4972504); Reuhl (US 5873069); Riordan (US 6078891); Sloane (US 5918211); Day (US 5857175) Should be Reversed	<u>15</u>
	a. Claims 5-13 and Claim 5-13/23	<u>15</u>
	b. Claims 14-22 and claim 14-22/23	<u>17</u>
	c. Claims 28-39	<u>18</u>
	d. Claims 50-52	<u>19</u>
	e. Claim 55	<u>20</u>

III.	37 CFR 41.37 (c)(1) (continued)	<u>21</u>
H.	37 CFR 41.37 (c)(1)(viii) Claims Appendix	<u>21</u>
I.	37 CFR 41.37 (c)(1)(ix) Evidence Appendix	<u>21</u>
J.	37 CFR 41.37 (c)(1)(x) Related Proceedings Appendix	<u>21</u>
VII.	37 CFR 41.37 (c)(2)	<u>22</u>
VIII.	37 CFR 41.37 (d)	<u>22</u>
IX	37 CFR 41.37 (e)	<u>22</u>
	APPENDIX I - CLAIMS APPENDIX	<u>23</u>
	APPENDIX II - EVIDENCE APPENDIX	<u>32</u>
	APPENDIX III - RELATED PROCEEDINGS	<u>33</u>

I. **37 CFR 41.37 (a)(1) and (2) - Notice Of Appeal, Brief, and Fees -**

On February 4, 2005, the applicant (1) filed a Notice of Appeal under 41.31 and (2) paid the fee set forth in 41.20(b)(2) of \$1000. On March 11, 2005 the applicant refiled the notice of appeal and an appeal brief, with authorization to charge for any fee deficiency. The current fee for filing a notice of appeal or an appeal brief is \$510. The difference is \$20 which the applicant submits herewith. Since EFS web does not provide for a payment of \$20.00, the applicant paid that fee today, 8/6/2008, via other channels.

II. **37 CFR 41.37 (b) - Dismissal of Appeal if Brief and Fees Untimely**

The filing is timely. Accordingly, this subsection is not relevant.

III. **37 CFR 41.37 (c)(1)**

The brief contains items (i) to (x) of this subsection.

A. **37 CFR 41.37 (c)(1)(i) Real Party in Interest**

The real party in interest is Catalina Marketing Corporation, a Delaware corporation.

B. **37 CFR 41.37 (c)(1)(ii) - Identification of Related Appeals and Interferences**

There are no related appeals or interferences.

C. **37 CFR 41.37 (c)(1)(iii) - Status of Claims and Identification of Claims, and Identification of Claims being Appealed**

Claims 1-55 are pending. Claims 1-55 are rejected.

Claims 1-4, 24-27, 40-49, 53-54 are not appealed. The rejections of the remaining ones of claims 1-55, which are claims 5-23, 28-39, 50-52, and 55, are appealed.

D. **37 CFR 41.37 (c)(1)(iv) - Status of Amendments**

Any amendment filed after final rejection has been entered. No amendment has not been entered.

E. 37 CFR 41.37 (c)(1)(v) - Summary of the Claimed Subject Matter

Claim 1 defines a computer-implemented method (specification page 4 line 27 through page 5 line 8; Figure 1, 108) comprising the steps of: obtaining information from a plurality of retail stores to determine an identification (specification page 8 lines 13-14; Figure 1, 108, 112, 116; Figure 2, 203, 205; Figure 3, 303, 305) and price paid for purchased items (specification page 8 lines 7-8; Figure 1, 108, 112, 116; Figure 2, 207; Figure 3, 307; Figure 5); recording in a central price-paid database remote from the retail stores at least one of an item identification and the price-paid for each of the purchased items (specification page 5 lines 12-14; Figure 1, 108, 112, 116) by recurrently obtaining on a predetermined schedule from checkout computers at the retail stores said information about the price paid for purchased items (specification page 5 lines 25-27; Figure 1, 108, 112, 116); and publishing the price-paid database (specification page 8 lines 17-20; Figure 1, 110, 112, 116; Figure 4, 404).

Claim 24 defines a system for enabling a user to obtain pseudo-real-time data on prices paid for purchased items at a plurality of retail stores (specification page 5 lines 29-31; Figure 1, 100, 108, 110, 112, 116; Figure 5), comprising: a scanner configured to determine an identification of the purchased items; a checkout computer connected to the scanner and configured to determine a price paid for each of the purchased items (specification page 8 lines 1-5; Figure 1, 116, 118); and a central computer remote from the retail stores and configured to record from the plurality of retail stores in a price-paid database at least one of an item identification and the price-paid for each of the purchased items (specification page 7 line 29 through page 8 line 1; Figure 1, 108, 114, 116, 118; Figure 4, 402), to recurrently obtain on a predetermined schedule information on the price paid for each of the purchased items from the retail stores (specification page 5 lines 25-27; Figure 1, 108, 114, 116), and to publish the price-paid database (specification page 8 lines 17-20; Figure 1, 110, 112, 116; Figure 4, 404).

The invention of claim 40 defines a price-paid database aggregated from a plurality of retail stores (specification page 5 lines 12-14; Figure 1, 112), comprising: a first field for storing an item identification corresponding to an item purchased from the plurality of retail stores

(specification page 5 lines 25-27; Figure 1, 108, 114, 116; Figure 2, 205; Figure 3; 305); and a second field for storing the price paid for said item purchased (specification page 5 lines 18-21; Figure 1, 112, 120; Figure 2, 207; Figure 3; 307).

Claim 5 recites "2. The method of Claim 1, wherein the step of obtaining the information comprises: obtaining a customer identification associated with each purchased item {page 3 lines 18-21}. 5. The method of Claim 2, wherein the step of obtaining the information comprises: recording the identification and the price paid for each of the purchased items in the checkout computer {page 3 lines 13-21}; and recurrently uploading the recorded identification and the price-paid to a central computer containing the price-paid database {page 3 lines 18-21}.

Claim 14 defines "2. The method of Claim 1, wherein the step of obtaining the information comprises: obtaining a customer identification associated with each purchased item {page 3 lines 13-21}. 14. The method of Claim 2, wherein the step of obtaining the information comprises: recurrently requesting transfer of the identification and the price-paid from the checkout computer to the central computer containing the price-paid database {page 13 lines 18-21}."

Claim 28 recites "28. The system of Claim 24, wherein the checkout computer is configured to record a customer identification and the price paid for each of the purchased items in a checkout computer {page 3 lines 13-21} and recurrently upload the recorded identification and the price-paid to the central computer {page 3 lines 18-21}."

Claim 50 recites "50. The method of Claim 1, wherein the step of recording comprises: recurrently recording the identification and the price paid at a point of sale received from a sequential request from the central computer to a checkout computer at each of the retail stores {page 3 lines 13-21 and page 9 lines 1-3, Fig. 5, step 504}.

Claim 51 recites "51. The system of Claim 24, wherein the central computer is configured to recurrently record the identification and the price paid at a point of sale received from a sequential request from the central computer to the checkout computer at each of the retail stores {page 3 lines 13-21 and page 9 lines 1-3, Fig. 5, step 504}."

Claim 52 recites "52. The database of Claim 40, wherein the price paid stored in the

second field {Fig. 2, price paid table 201, page 6 lines 20-24, and page 6 line 30 to page 7 line 5} is received in the second field on a predetermined schedule made by a sequential request from the central computer to the checkout computer at each of the retail stores {page 3 lines 13-21 and page 9 lines 1-3, Fig. 5, step 504}."

Claim 55 recites "55. The database of Claim 40, wherein the price paid stored in the search field is received for a checkout computer on a predetermined schedule after a predetermined number of purchases have been made {page 9 lines 15-17}."

F. 37 CFR 41.37 (c)(1)(vi) - Grounds of Rejection to be Reviewed on Appeal

Whether the rejection of claim 1 under 35 USC 112 should be reversed.

Whether the rejections of claims 45-55 under 35 USC 101 should be reversed.

Whether the rejections of claims 1-55 under 35 USC 103 should be reversed. These rejections rely variously upon the following US patent evidence of prior art: Daniel (US 4972504); Reuhl (US 5873069); Riordan (US 6078891); Sloane (US 5918211); and Day (US 585717).

The appellant does not contend that claims 1-4, 24-27, 40-49, 53-54 are patentable. BPAI precedent in such a situation authorizes the examiner to cancel these claims. Cf. Ex parte Letts; Ex parte Ghuman, <http://www.uspto.gov/web/offices/dcom/bpai/prec.htm>.

However, appealed claims depend from some of claim 1-4, 24-27, 40-49, 53-54. Issues raised by the rejection of claims 1-4, 24-27, 40-49, 53-54, but not raised in rejections of appealed claims, are common with the appealed claims. For example, whether appealed claims are indefinite for the reason the examiner presented for claim 1 when the basis for that reason relates directly to all claims. For example, ambiguity in the office action as to which claims are rejected under 35 USC 101. In addition, support for claims as specified here in above will be substantially simpler for the panel to understand, as presented above, than if claims 1-4, 24-27, 40-49, 53-54 are canceled prior to appeal.

Therefore, canceling 1-4, 24-27, 40-49, 53-54 prior to appeal would confuse the issues that must be decided in the appeal. Accordingly, the appellant suggests that the examiner

forward the appeal to the BPAI without canceling claims 1-4, 24-27, 40-49, 53-54, noting the examiner's right to do so, post appeal.

G. 37 CFR 41.37 (c)(1)(vii) Argument

The contentions of the appellant with respect to each ground of rejection. Each ground of rejection must be treated under a separate heading (not sub heading).

IV. Whether the Rejection of Claim 1 under 35 USC 112 Should Be Reversed

This rejection is not moot because it impacts appealed claims depending from claim 1.

The examiner erred by mis applying the facts and the law, as explained below.

Accordingly, the panel should reverse this rejection.

The examiner rejects claim 1 reasoning as follows:

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites "publishing the price paid database". It is not clear how a database can be published. Appropriate correction is required.

For examination purposes, the claim will be interpreted as publishing the content of the database.

This rejection is erroneous, and improper, and should be reversed.

35 USC 112, second paragraph states that "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The Court of Appeals for the Federal Circuit has specified the procedure to determine compliance with 35 USC 112, second paragraph is to construe the claims in view of their words and grammar, the specification, and the file history. Cf. Trovan Ltd. v. Sokymat SA, Docket No. 01-1360(Fed. Cir. August 1, 2002), slip opinion at 20. ("After

looking to the claim language we consider the rest of the intrinsic evidence, that is, the written description and the prosecution history, if in evidence.")

A claim is indefinite only if one skilled in the art cannot determine if subject matter it covered by the claim. Cf. Tegal Corp. v. Tokyo Electron Am., Inc., 257 F.3d 1331, 1342, 59 USPQ2d 1385, 1393 (Fed. Cir. 2001)("The words used in the claims are examined through the viewing glass of a person skilled in the art.") and Microprocessor Enhancement Corp. v. Texas Instruments Inc., ___ F.3d ___ (Fed. Cir. 2008)("we note that "[a] claim that is amenable to construction is not invalid on the ground of indefiniteness" if the construction renders the claim definite. Energizer Holdings, 435 F.3d at 1371. ").

The examiner's assertion that claim 1's "publishing the price paid database" makes claim 1 indefinite is error. The evidence shows that claim 1 is neither indefinite on its face nor incapable, to the extent necessary, to be construed in view of the specification.

First, prior examiners in this application have had no trouble understanding the scope of claim 1. No prior examiner rejected claim 1 on the theory that "publishing the price paid database" was indefinite. On 2/10/2004, Examiner Charles signed an office action presumably approved by her supervisor that contained no indefiniteness rejections, and the claim 1 she examined in that office action recited "publishing the price-paid database". On 11/4/2004, Examiner Charles signed a final office action presumably approved by her supervisor that contained no indefiniteness rejections, and the claim 1 she examined in that office action recited "publishing the price-paid database". She clearly understood what publishing the price paid database defined.

The current examiner also understands what claim 1 defines. Note the statement of this examiner, presumably approved by his supervisor, "For examination purposes, the claim will be interpreted as publishing the content of the database." That statement shows that this examiner and presumably his supervisor understand "publishing the price paid database" to mean publishing the content of the price paid database. That is, this examiner understands the scope of claim 1. The examiner's interpretation of claim 1, presumably approved by his supervisor, contradicts the examiner's assertion that claim 1 is indefinite.

Moreover, there is no basis for the examiner's rejection in fact or law.

As a matter of law, the examiner failed to perform a proper legal analysis and instead merely stated a conclusion, that "It is not clear how a database can be published. " That is insufficient as a matter of law to support the rejection. The examiner failed to examine the meaning of the words in claim 1, the grammar of claim 1, or if that was insufficient, the specification and file history.

Specifically, the examiner failed to determine the meaning of the words "publishing" and "database" before asserting a bare conclusion. Such a failure is legal error and therefore fails as a matter of law to make a prima facie case. Therefore, the indefiniteness rejection should be reversed.

Given the foregoing failure, the examiner improperly places the burden of defining the rejection on the appellant to ensure that the panel reverses the rejection. One consequence of that de facto burden shifting is that the appellant has to define "publish" and "database" to demonstrate how improper the rejection really is.

The examiner asserts that "publishing the price-paid database" means "publishing the content of the [price paid] database." However, there is in fact no difference in meaning between "publishing the price-paid database" and "publishing the content of the price paid database" in view of the meaning of "publish" and "database".

Publishing means to make a particular work available, generally known, for example by producing in printed or electronic form. The panel is invited to take administrative notice of the meaning of publish from any online dictionary, for example from Encarta® World English Dictionary, North American Edition; Compact Oxford English Dictionary; Merriam-Webster's Online Dictionary, 10th Edition, only because those three happen to be the first listed in a search on <http://www.onelook.com/> for dictionaries listing "publish".

Database means a structured collection of data on a computer. Again, the panel is invited to refer to any dictionary, such as those available from <http://www.onelook.com/> if it deems it necessary to define database.

Given those definitions, "publishing the price-paid database" means making the price

paid database generally available, for example by producing it in printed or electronic form. That is no different in meaning from making the content of the price paid database generally available, for example by producing it in printed or electronic form. Hence, the examiner's interpretation of "publishing the price-paid database" for "purposes of examination" is no different than the actual meaning of that phrase based upon the plain meaning of the words.

Moreover, the examiner failed to consider whether his alleged lack of understanding of the meaning of the phrase "publishing the price-paid database" was cured by the description in the specification. Failure to consider the specification was also legal error since claims are not construed in a vacuum; they must be viewed in light of the specification. Thus, the examiner failed to consider, for example, published paragraph 0040 of the published version of the specification. That paragraph reads as follows:

[0040] In one embodiment of the present invention, the central computer 116 publishes the central price-paid database 112 through the web-page 110 which can be customer-selected to specify a particular district, sales category, product (e.g., CRESTS toothpaste in an 8 ounce container) or customer category (e.g., all customers within the state of Florida). Other publishing methods, such as for example the publication of indexed volumes of the price paid database, are generated according to the present invention by the central computer 108. The indexed volumes are available through a subscription which provides subscribers with current volumes of the price-paid database. In general, the publishing methods of the present invention disseminate information in the price-paid database to users in an electronic, magnetic, or paper format.

Paragraph 0040 of the specification is consistent and in fact corresponds in scope with the plain meaning of publish, as indicated by the foregoing definitions, since it lists examples of publishing as including electronic means via web pages 110 and via printing via indexed volumes. In fact, paragraph 0040 refers to these examples as "publish[ing of] ...the central

price-paid database", which is essentially exactly what claim 1 recites. Thus, contrary to the examiner's assertion, the specification clearly defines what claim 1 means by "publishing the price paid database", and that definition is consistent with the literal meaning of "publishing the price paid database" based upon the meanings of the words publish and database.

For all of the foregoing reasons, the examiner erred in rejecting claim 1 as indefinite.

V. Whether the Rejections of Claims 45-55, or of Claims 40-49, 52 and 55, or of claims 40-55, Under 35 USC 101, Should Be Reversed

This or these rejections are not moot because (1) at least some of the claim identified The office action remain pending and under appeal, and it is unclear exactly to which claims this rejection applies.

The examiner erred for the many reasons noted below.

1. Summary

The examiner rejects claims 45-55 under 35 USC 101 stating that:

Claims 45-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 40-49, 52 and 55 are directed to a computer program per se or data structure of a computer or software and therefore not statutory under 35 U.S. C.

101. This is exemplified in In re Warmerdam 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

Functional descriptive material claimed in combination with an appropriate computer readable medium to enable the functionality to be realized is patent eligible subject matter if it is capable of producing a useful, concrete and tangible result when used in the computer system. Compare Warmerdam to In re Lowry 32 USPQ2d 1031 where a memory with a data structure that increased computing

efficiency was patentable.

The computer readable medium loaded with a computer program and in association with a computer provides the functional descriptive material in usable form to permit the functionality to be realized with the computer. A program product which does not explicitly include such a medium, a program per se, a signal or other type of transmission media that fails to include the hardware necessary to realize the functionality (e.g., a transmitter or a receiver), and a piece of paper with the functional descriptive material written on it are all examples of media which are not believed to enable the functionality to be realized with the computer. [5/6/2008 office action page 3.]

In reply, the applicant first submits that the rejection is improper and should be withdrawn for several reasons.

First, the examiner erred by not specifying which claims are rejected under 101. The first paragraph appears to reject claims 45-55. However, the second paragraph refers to claims 40-49, 52 and 55. Are claims 45-55, or claims 40-49, 52, and 55 rejected?

Second, the examiner erred by not providing a reasoned basis supporting the rejection because the examiner did not construe the claims, and construing the claims is fundamental to a conclusion to reject claims under any basis. Specifically, the examiner stated that "Claims 40-49, 52 and 55 are directed to a computer program per se or data structure of a computer or software." That broad brush characterization fails to consider the meaning of the recitations in each claim. Thus, the examiner erred in not presenting a prima facie case.

Third, the examiner erred by concluding that "Claims 40-49, 52 and 55... [are] not statutory under 35 U.S. C. 101" because they are allegedly "directed to a computer program per se or data structure of a computer or software." In this regard, the examiner's erred in relying upon Wamerdam to support blanket 35 USC 101 rejections of databases, related code, and programmed computer systems.

2. **Mis-Application of Warmerdam**

Warmerdam, cited by the examiner, it is inapposite. Warmerdam stands for the proposition that claims to a computer algorithm, per se, do not comply with 35 USC 101. In Warmerdam, the court rejected claim 6 because it did not further define the algorithm claims from which it depended. In contrast, claims 40-55 in this application are not mere algorithm claims, are therefore unrelated is subject matter to claim 6 in Warmerdam. Consequently, the holding in Warmerdam is irrelevant to claims 40-55 in this application.

In more detail, the Court in Wamerdam indicated that Warmerdam's claim 1/6 read as follows:

1. A method for generating a data structure which represents the shape of [sic] physical object in a position and/or motion control machine as a hierarchy of bubbles, comprising the steps of: first locating the medial axis of the object and then creating a hierarchy of bubbles on the medial axis. ... 6. *A data structure generated by the method of any of Claims 1 through 4.*

In Warmerdam, the Court concluded claim 6 defined a mere mathematical algorithm, not printed matter, and not a data structures. The Court affirmed the rejection of claim 6 under 35 USC 101 solely because it defined no more than a mere mathematical algorithm.

The Court noted that Warmerdam's claim 6 defined "nothing more than another way of describing the manipulation of ideas contained in claims 1-4," and therefore it concluded that Warmerdam's claim 6 "suffers from the same fatal defect" as claims 1-4. The basis for the Court to reject Warmerdam's claims 1-4 was because, "As a whole, the claim [sic; claims 1-4] involves no more than the manipulation of abstract ideas." That is why the Court in Warmerdam agreed with the reasons presented by the Commissioner that claim 6 - - "is not one of the categories of subject matter recited in § 101, to wit, a process, machine, manufacture, composition of matter, or an improvement thereof". Thus, any reading of Warmerdam leads to only one conclusion. That Warmerdam's claim 6 did not add any limitations to claims 1-4 and therefore failed 35 USC

101 because it defined no more than the manipulation of abstract ideas. Therefore, Warmerdam is precedent supporting a rejection under 35 USC 101 only an facial claim to a data structure that in fact fails to define more than a mere mathematical algorithm. Warmerdam is not precedent supporting the examiner's contention that claims defining "computer program per se or data structure of a computer or software" violate 35 USC 101. Therefore the rejections of any of claims 40-55 under 35 USC 101 are improper and should be reversed.

3. Improper Reliance Upon Lowry

Fourth, the examiner's reliance upon Lowry to support 35 USC 101 rejections of claims is also error. This is because, according the Lowry Court, (1) the Board reversed the 101 rejections of Lowry's appealed claims and (2) the only issue the Lowry Court decided was obviousness. As to (1), the Lowry Court stated that "The Board reversed the 35 U.S.C. § 101 rejection. The Board found that claims 1 through 5, directed to a memory containing stored information, as a whole, recited an article of manufacture. The Board concluded that the invention claimed in claims 1 through 5 was statutory subject matter." Lowry's claim 1, presented in the Lowry Court's opinion, to the extent relevant to the 101 issue, is indistinguishable from claims 40-55 in this application. Compare to claims 40-55 in this application, the preamble of Lowry claim 1, which reads "1. A memory for storing data for access by an application program being executed on a data processing system, comprising:". Accordingly, the examiner erred to the extent he (1) relied upon the Lowry Court's opinion to support a 35 USC 101 rejection, and by ignoring the Board's reversal of the 101 rejection of Lowry's claims. Accordingly, there is no legal basis for 101 rejection of any one of claims 40-55.

4. Misapplication of Printed Matter Theory

Finally, the applicant also addresses any printed matter theory for a 35 USC 101 rejection. In this regard, the applicant first construes "database" as recited in claim 40. Claim 40 recites:

40. A price-paid database aggregated from a plurality of retail stores, comprising:

a first field for storing an item identification corresponding to an item purchased from the plurality of retail stores; and
a second field for storing the price paid for said item purchased.

The meaning of claims defined by the words and grammar of the claims, the meaning assigned to those words by the specification and the file history The USPTO is entitled to construe claims to have their broadest reasonable meaning consistent with those doctrines of claim construction. In re Prater, ___ F.2d ___, ___, 162 USPQ 541, 550-51 (CCPA 1969)(as to USPTO interpretation) and Markman v. Westview Instruments, Inc., 52 F.3d 967, 979, 34 USPQ2d 1321, 1329(Fed. Cir. 1995); aff'd at 117 S.Ct. 1040, 38 USPQ2d 1461 (1996)(as to claim construction principles).

The common meaning of "database" is an organized body of related information. However, this specification is directed to a computer implemented invention in which the database is stored in a computer system. In this regard, the abstract states "A central computer records in a price-paid database an item identification and price-paid for each purchased items." Thus, the computer system stores in memory associations of logically related data items. Paragraph 0034 of the publication of this application states of the databases, including the price paid database, "The databases are organized using data structures (e.g., records, tables, arrays, fields, graphs, trees, and/or lists) contained in one or more memories, such as the memories listed above or any of the storage devices listed below in the discussion of FIG. 7, for example. Reference to "data structures (e.g., records, tables, arrays, fields, graphs, trees, and/or lists) contained in one or more memories" necessarily implies corresponding coding in order to understand the meaning of those data structures in order to access the stored data. Unlike printed paper, data stored on a computer is not written material; it require, necessarily, either operating system code (as for flat files) or a database management program's code (such as MS Access, Sequel Server, DB2, etc) to understand both the file name and location, and the file structure and attributes.

Accordingly, the "database" defined by claim 40 inherently defines both data and

corresponding coding in a computer system distinguishing the subject matter defined by claim 40 from mere printed matter. The applicant therefore submits that claims 40-44 are statutory subject matter under 35 USC 101 at least because the inherently define and associate with one another different types of data in hardware. This association may include code in the sense that it instructs a corresponding computer system how the data is related.

Accordingly, any rejection of claim 40 under 35 USC 101 based upon a printed matter theory is improper, and if present, should be reversed.

Claims 50 and 55 depend from claim 1. For the same reasons, any such rejection of claims 50 and 55 should be reversed .

Claims 50 depends from claim 1. As explained in section 1, the examiner admitted that he understood the scope of claim 1. The examiner has not explained how claim 1 could be rejected under a printed matter theory, and therefore has not explained how claim 50 could be so rejected. For this additional reason, any rejection of claim 50 based upon a mere printed matter theory relying upon 35 USC 101 is improper and should be reversed.

Claims 51 depends from claim 24. The examiner has not explained how claim 24 could be rejected under a printed matter theory, and therefore has not explained how claim 51 could be so rejected. For this additional reason, any rejection of claim 51 based upon a mere printed matter theory relying upon 35 USC 101 is improper and should be reversed.

Claims 52 depends from claim 40. Claims 52 defines "the central computer is configured to recurrently record the identification and the price paid at a point of sale received from a sequential request from the central computer to the checkout computer at each of the retail stores." Thus, claim 52 is expressly limited to include a central computer configured to perform operations, a machine programmed to perform a specific operation. Such subject matter is clearly not equivalent to mere printed matter. The examiner erred in not recognizing this fact. For this additional reason, any rejections of claim 52 based upon a mere printed matter theory relying upon 35 USC 101 is improper and should be reversed.

VI. Whether the Rejections of Claims 1-55 under 35 USC 103, Which Rely Upon: Daniel

**(US 4972504); Reuhl (US 5873069); Riordan (US 6078891); Sloane (US 5918211);
Day (US 5857175) Should be Reversed**

a. Claims 5-13 and Claim 5-13/23

The examiner erred in relying upon Daniel to suggest claim 5's limitations.

Claim 5 reads as follows:

1. A computer-implemented method comprising the steps of:
obtaining information from a plurality of retail stores to determine an
identification and price paid for purchased items;
recording in a central price-paid database remote from the retail stores at
least one of an item identification and the price-paid for each of the purchased
items by recurrently obtaining on a predetermined schedule from checkout
computers at the retail stores said information about the price paid for purchased
items; and
publishing the price-paid database.
2. The method of Claim 1, wherein the step of obtaining the information
comprises:
obtaining a customer identification associated with each purchased item.
5. The method of Claim 2, wherein the step of obtaining the information
comprises:
**recording the identification and the price paid for each of the
purchased items in the checkout computer; and**
recurrently uploading the recorded identification and the price-paid to a
central computer containing the price-paid database.

The examiner erred in rejecting claim 5 by relying upon Daniel to disclose the claimed
step of obtaining information from a plurality of retail stores to determine an identification and
price paid for purchased items comprises **recording the identification and the price paid for**

each of the purchased items in the checkout computer.

The examiner also erred in rejecting claim 5 by relying upon Daniel to disclose the claimed step of "recurrently uploading the recorded identification [recorded in the **checkout computer**] and the price-paid to a central computer containing the price-paid database"

In fact, Daniel does not disclose the checkout computer performing either step. Moreover, what Daniel does disclose teaches away from the **checkout computer** performing either step.

Daniel discloses that its system 12 device, and only its system 12 device performs related functions. The passages cited by the examiner refer only to structure of and processes performed by device 12. Daniel teaches that device 12 and a checkout computer are distinct.

Daniel teaches away from having a **checkout computer** perform the two claimed functions identified above, stating that

"However, each such in-store device does not interfere with or require the active participation of the in-store Point-Of-Sale (POS) scanners/registers, POS controller or store computer controlling the normal operations of the retail store. " (abstract);

"Thus, a long-felt want and need has existed for a new and improved in-store market research retail sales data collection system and method that are substantially totally passive or non-invasive with respect to the regular operations and equipment of retail stores, thereby obviating the concerns referred to above of many store operators. Preferably, any such data collection system and method should also be independent of the in-store POS scanner/register controller and computer and also independent of host computers at the headquarters of retail store chains, thereby enabling market research data to be collected, stored and transmitted to a central location in accordance with the particular format found most advantageous by market researchers." (Background of the Invention section);

"However, the in-store device does not interfere with or require the active participation of the in-store controller or computer controlling the normal operation of the one or more POS terminals in each retail store. " (Summary of the Invention section); and

"However, the in-store device does not interfere with or require the active participation of

the in-store controller or Importantly, each in-store device operates in an unattended mode and requires no intervention by the retail store operators or by the retail store's POS terminals, controller or computer. The system and method of the present invention require no software or program modification to each retail store's controller or computer used in controlling the normal operations of each retail store." (Summary of the Invention section).

The examiner relies solely upon Daniel to disclose what claim 5 defines. Since Daniel does not disclose or suggest, and in fact teaches away, from what claim 5 defines, the examiner erred. The obviousness rejection of claim 3 should therefore be reversed.

Claims 6-13 and claim 5-13/23 depend either directly or indirectly upon claim 5. Therefore, the rejections of these claims should also be reversed.

b. Claims 14-22 and claim 14-22/23

The examiner erred in relying upon Daniel to suggest claim 14's limitations.
Claim 14 recites:

1. A computer-implemented method comprising the steps of:
obtaining information from a plurality of retail stores to determine an identification and price paid for purchased items;
recording in a central price-paid database remote from the retail stores at least one of an item identification and the price-paid for each of the purchased items by recurrently obtaining on a predetermined schedule from checkout computers at the retail stores said information about the price paid for purchased items; and
publishing the price-paid database.
2. The method of Claim 1, wherein the step of obtaining the information comprises:
obtaining a customer identification associated with each purchased item.
14. The method of Claim 2, wherein the step of obtaining the information

comprises:

recurrently requesting transfer of the identification and the price-paid from the checkout computer to the central computer containing the price-paid database.

For reasons presented for claim 5, Daniel does not disclose claim 14's limitation **"wherein the step of obtaining the information comprises: recurrently requesting transfer of the identification and the price-paid from the checkout computer to the central computer containing the price-paid database."** Therefore, the examiner erred in rejection claim 5, and the rejection should be reversed.

Claims 15-22 and claim 14-22/23 depend either directly or indirectly from claim 15. Therefore, the rejections of these claims should be reversed.

c. Claims 28-39

The examiner erred by relying upon Daniel to suggest claim 28's limitations.

Claim 28 recites:

24. A system for enabling a user to obtain pseudo-real-time data on prices paid for purchased items at a plurality of retail stores, comprising:

a scanner configured to determine an identification of the purchased items;
a **checkout computer** connected to the scanner and configured to determine a price paid for each of the purchased items; and

a central computer remote from the retail stores and configured to record from the plurality of retail stores in a price-paid database at least one of an item identification and the price-paid for each of the purchased items, to recurrently obtain on a predetermined schedule information on the price paid for each of the purchased items from the retail stores, and to publish the price-paid database.

28. The system of Claim 24, **wherein the checkout computer** is

configured to record a customer identification and the price paid for each of the purchased items in a checkout computer and **recurrently upload the recorded identification and the price-paid to the central computer.**

As explained for claim 5, Daniel does not disclose using a checkout computer to upload data for a price paid database, and in fact Daniel teaches away from using a checkout computer for that purpose. Claims 29-39 depend either directly or indirectly from claim 28. Therefore, the rejections of claims 28-39 should be reversed.

d. **Claims 50-52**

The examiner erred in relying upon Daniel to suggest claim 50's limitations.

Claim 50 recites:

1. A computer-implemented method comprising the steps of:
 - obtaining information from a plurality of retail stores to determine an identification and price paid for purchased items;
 - recording in a central price-paid database remote from the retail stores at least one of an item identification and the price-paid for each of the purchased items by recurrently obtaining on a predetermined schedule from checkout computers at the retail stores said information about the price paid for purchased items; and
 - publishing the price-paid database.
50. The method of Claim 1, wherein the step of recording comprises:
 - recurrently recording** the identification and the **price paid** at a point of sale received from a sequential **request from the central computer to a checkout computer** at each of the retail stores.

As explained for claim 5, Daniel does not disclose, and teaches away from, using a checkout computer in generating a price paid database. Therefore, nothing in Daniel suggests the

additional interaction of a central computer and a checkout computer in which the central computer instructing a checkout computer to transmit to the central computer priced paid data as defined by claim 50. Therefore, the rejection of claim 50 should be reversed.

Claim 51 recites in part:

51. The system of Claim 24, wherein the central computer is configured to recurrently record the identification and the price paid at a point of sale received from **a sequential request from the central computer to the checkout computer** at each of the retail stores.

Claim 52 recites in part:

52. The database of Claim 40, wherein the price paid stored in the second field is received in the second field on a predetermined schedule made by **a sequential request from the central computer to the checkout computer** at each of the retail stores.

Claims 51 and 52 define a system have a limitation equivalent to that noted in claim 50. Therefore, the rejection of claim 51 should be reversed.

e. **Claim 55**

The examiner erred in relying upon Daniel to teach the claimed use of the checkout computer defined by claim 55.

Claim 55 recites:

40. A price-paid database **aggregated from a plurality of retail stores**, comprising:

a first field for storing an item identification corresponding to an item purchased from the plurality of retail stores; and

a second field for storing the price paid for said item purchased.

55. The database of Claim 40, wherein the **price paid stored in the search field is received for a checkout computer on a predetermined schedule after a predetermined number of purchases have been made.**

Claim 55 defines a price paid database wherein the price paid stored in the search field is received for [sic; from] a checkout computer on a predetermined schedule after a predetermined number of purchases have been made. The examiner relies upon Daniel to suggest claim 55. However, the examiner does not address the limitations of claim 55. Moreover, as noted above, Daniel does not disclose, and in fact teaches away from, using a checkout computer to assemble a price paid database. Therefore, Daniel would not disclose the additional limitation of the database receiving data from a checkout computer, or receiving that data after a predetermined number of purchases on a predetermined schedule, as claimed. Therefore, the rejection of claim 55 should be reversed.

III. **37 CFR 41.37 (c)(1) (continued)**

H. **37 CFR 41.37 (c)(1)(viii) Claims Appendix**

Appendix I is attached which contains a copy of the claims involved in the appeal.

I. **37 CFR 41.37 (c)(1)(ix) Evidence Appendix**

There is no evidence submitted pursuant to 1.130, 1.131, or 1.132 of this title or any other evidence entered by the examiner and relied upon by appellant in the appeal. Accordingly, this section is inapplicable. A blank evidence appendix, Appendix II, page is attached to formally comply.

J. **37 CFR 41.37 (c)(1)(x) Related Proceedings Appendix**

There are no related appeals or interferences under (c)(1)(ii) of this section. Accordingly, this section is inapplicable. A blank related proceedings appendix, Appendix III, page is attached to formally comply.

VII. 37 CFR 41.37 (c)(2)

This brief does not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence.

VIII. 37 CFR 41.37 (d)

This appeal brief complies with all the requirements of paragraph (c) of this section.

IX 37 CFR 41.37 (e)

The applicant timely filed a notice of appeal on February 4, 2005 with suitable extensions of time under 37 CFR 1.136. A new notice of appeal is filed herewith, as required by BPAI procedure specified on the BPAI web site.

8-6-2008

DATE

Respectfully Submitted,

/RichardNeifeld#35,299/

Richard A. Neifeld

Attorney of Record

Registration No. 35,299

ran

Printed: August 6, 2008 (1:11pm)

Y:\Clients\Catalina\PIP-53-FITZ\PIP-53-FITZ-US\Drafts\AppealBriefReinstatingTheAppeal_PIP-53-FITZ-US_7-25-2008.wpd

APPENDIX I - CLAIMS APPENDIX

Note: The appellant interprets "claims involved in the appeal" within the meaning of 37 CFR 41.37(c)(viii) includes claims from which appealed claims depend.

1. A computer-implemented method comprising the steps of:
obtaining information from a plurality of retail stores to determine an identification and price paid for purchased items;
recording in a central price-paid database remote from the retail stores at least one of an item identification and the price-paid for each of the purchased items by recurrently obtaining on a predetermined schedule from checkout computers at the retail stores said information about the price paid for purchased items; and
publishing the price-paid database.
2. The method of Claim 1, wherein the step of obtaining the information comprises:
obtaining a customer identification associated with each purchased item.
3. The method of Claim 2, wherein the step of obtaining a customer identification comprises:
scanning at least one of a frequent shopper card, a credit card, a club member card, and a debit card.
4. The method of Claim 2, wherein the step of obtaining a customer identification comprises:
scanning at least one of a fingerprint, retinal scan, and a signature.
5. The method of Claim 2, wherein the step of obtaining the information comprises:
recording the identification and the price paid for each of the purchased items in the checkout computer; and

recurrently uploading the recorded identification and the price-paid to a central computer containing the price-paid database.

6. The method of Claim 5, further comprising:
comparing the price paid to an inventory list price;
recording at least one of the inventory list price and a price differential between the inventory list price and the price paid; and
recurrently uploading the at least one of the inventory list price and the price differential to the central computer.

7. The method of Claim 6, further comprising:
recording at least one of the customer identification and a store identification; and
recurrently uploading the at least one of the customer identification and a store identification to the central computer.

8. The method of Claim 7, wherein the step of recording comprises:
formatting the price-paid database into columnar entries, wherein the columnar entries include at least one of the customer identification, the store identification, the purchase item identification, the price-paid, the list price, and the price differential.

9. The method of Claim 8, wherein the step of publishing comprises:
providing on a web page the price-paid database.

10. The method of Claim 9, wherein the step of providing comprises:
selecting from the web page price-paid information from at least one of a store selection, a customer selection, a brand selection, and a sales category selection within a specified district.

11. The method of Claim 9, wherein the step of selecting comprises:

determining one of a zip code and an area code of the user; and
restricting the specified district to an area within the one of a zip code and an area code.

12. The method of Claim 9, wherein the step of selecting comprises:
determining one of a remote district, a regional district, and a national district for the user; and
restricting the specified district to an area within the one of a remote district, a regional district, and a national district.

13. The method of Claim 9, wherein the step of providing comprises:
selecting from the web page price-paid information from stores within a specified district.

14. The method of Claim 2, wherein the step of obtaining the information comprises:
recurrently requesting transfer of the identification and the price-paid from the checkout computer to the central computer containing the price-paid database.

15. The method of Claim 14, further comprising:
recurrently requesting transfer of at least one of an inventory list price and a price differential between the inventory list price and the price paid to the central computer.

16. The method of Claim 15, further comprising:
recurrently requesting transfer of at least one of a customer identification and a store identification to the central computer.

17. The method of Claim 16, wherein the step of recording comprises:
formatting the price-paid database into columnar entries, wherein the columnar entries include at least one of the customer identification, the store identification, the purchase item identification, the price-paid, the list price, and the price differential.

18. The method of Claim 17, wherein the step of publishing comprises:
providing on a web page the price-paid database.
19. The method of Claim 18, wherein the step of providing comprises:
selecting from the web page price-paid information from at least one of a store selection,
a customer selection, a brand selection, and a sales category selection within a specified district.
20. The method of Claim 18, wherein the step of selecting comprises:
determining one of a zip code and an area code of the user; and
restricting the specified district to an area within the one of a zip code and an area code.
21. The method of Claim 18, wherein the step of selecting comprises:
determining one of a remote district, a regional district, and a national district for the
user; and
restricting the specified district to an area within the one of a remote district, a regional
district, and a national district.
22. The method of Claim 18, wherein the step of providing comprises:
selecting from the web page price-paid information from stores within a specified district.
23. A computer readable medium containing program instructions for execution on a
computer system which when executed by the computer system, cause the computer system to
perform the method recited as in any one of claims 1-22.
24. A system for enabling a user to obtain pseudo-real-time data on prices paid for
purchased items at a plurality of retail stores, comprising:
a scanner configured to determine an identification of the purchased items;
a checkout computer connected to the scanner and configured to determine a price paid

for each of the purchased items; and

a central computer remote from the retail stores and configured to record from the plurality of retail stores in a price-paid database at least one of an item identification and the price-paid for each of the purchased items, to recurrently obtain on a predetermined schedule information on the price paid for each of the purchased items from the retail stores, and to publish the price-paid database.

25. The system of Claim 24, wherein the scanner is configured to determine a customer identification.

26. The system of Claim 25, wherein the scanner is configured to scan at least one of a frequent shopper card, a credit card, a club member card, and a debit card.

27. The system of Claim 25, wherein the scanner is configured to scan at least one of a fingerprint, retinal scan, and a signature.

28. The system of Claim 24, wherein the checkout computer is configured to record a customer identification and the price paid for each of the purchased items in a checkout computer and recurrently upload the recorded identification and the price-paid to the central computer.

29. The system of Claim 28, wherein the checkout computer is further configured to compare the price paid to an inventory list price, record at least one of the inventory list price and a price differential between the inventory list price and the price paid, and recurrently upload the at least one of the inventory list price and the price differential to the central computer.

30. The system of Claim 29, wherein the checkout computer is configured to record at least one of the customer identification and a store identification and recurrently upload the at least one of the customer identification and a store identification to the central computer.

31. The system of Claim 30, wherein the central computer is configured to format the price-paid database into columnar entries, wherein the columnar entries include at least one of the customer identification, the store identification, the purchase item identification, the price-paid, the list price, and the price differential.

32. The system of Claim 31, wherein the central computer is configured to publish a web page including the price-paid database.

33. The system of Claim 32, wherein the web page includes price-paid information from at least one of a store selection, a customer selection, a brand selection, and a sales category selection within a specified district.

34. The system of Claim 24, wherein the central computer is configured to recurrently request transfer of the identification and the price-paid from the checkout computer.

35. The system of Claim 34, wherein the central computer is configured to recurrently request transfer of at least one of an inventory list price and a price differential between the inventory list price and the price paid from the checkout computer.

36. The system of Claim 35, wherein the central computer is configured to recurrently request transfer of at least one of customer identification and a store identification from the checkout computer.

37. The system of Claim 36, wherein the central computer is configured to format the price-paid database into columnar entries, wherein the columnar entries include at least one of the customer identification, the store identification, the purchase item identification, the price-paid, the list price, and the price differential.

38. The system of Claim 37, wherein the central computer is configured to publish a web page including the price-paid database.

39. The system of Claim 38, wherein the web page includes price-paid information from at least one of a store selection, a customer selection, a brand selection, and a sales category selection within a specified district.

40. A price-paid database aggregated from a plurality of retail stores, comprising:
a first field for storing an item identification corresponding to an item purchased from the plurality of retail stores; and
a second field for storing the price paid for said item purchased.

41. The database of Claim 40, further comprising:
a third field for storing a customer identification.

42. The database of Claim 41, wherein the customer identification comprises:
at least one of a frequent shopper card, a credit card, a club member card, and a debit card.

43. The database of Claim 41, wherein the customer identification comprises:
at least one of a fingerprint, retinal scan, and a signature.

44. The database of Claim 40, further comprising:
a third field for storing at least one of the inventory list price and a price differential between the inventory list price and the price paid.

45. The database of Claim 44 wherein the price-paid database is configured to format the price-paid database into columnar entries, wherein the columnar entries include at least one of

the customer identification, the store identification, the purchase item identification, the price-paid, the list price, and the price differential.

46. The database of Claim 45, wherein the information in the price-paid database is formatted to be displayed as a web page.

47. The database of Claim 46, wherein the web page permits selection from the web page of price-paid information from at least one of a store selection, a customer selection, a brand selection, and a sales category selection within a specified district.

48. The database of Claim 46, wherein the web page permits selection from the web page of price-paid information by one of a user zip code and a user telephone area code.

49. The database of Claim 46, wherein the web page permits selection from the web page of price-paid information by one of a remote district, a regional district, and a national district.

50. The method of Claim 1, wherein the step of recording comprises:
recurrently recording the identification and the price paid at a point of sale received from a sequential request from the central computer to a checkout computer at each of the retail stores.

51. The system of Claim 24, wherein the central computer is configured to recurrently record the identification and the price paid at a point of sale received from a sequential request from the central computer to the checkout computer at each of the retail stores.

52. The database of Claim 40, wherein the price paid stored in the second field is received in the second field on a predetermined schedule made by a sequential request from the central computer to the checkout computer at each of the retail stores.

53. The method of Claim 1, wherein the step of recording comprises:
recurrently recording the price paid at a point of sale by reporting the identification and the price paid to the central computer after a predetermined number of purchases have been made.

54. The system of Claim 24, when the check out computer is configured to report the identification and the price paid to the central computer after a predetermined number of purchases have been made.

55. The database of Claim 40, wherein the price paid stored in the search field is received for a checkout computer on a predetermined schedule after a predetermined number of purchases have been made.

APPENDIX II - EVIDENCE APPENDIX

No evidence is submitted.

APPENDIX III - RELATED PROCEEDINGS

There are no related proceedings.

Printed: August 6, 2008 (1:11pm)

Y:\Clients\Catalina\PIP-53-FITZ\PIP-53-FITZ-US\Drafts\AppealBriefReinstatingTheAppeal_PIP-53-FITZ-US_7-25-2008.wpd